

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC WEYDERT,
UWE E, FRANK, RENE J. ZIMMER
and FILOMENO G. CORVASCE

Appeal 2007-0103
Application 10/603,023
Technology Center 1700

Decided: November 17, 2006

Before KIMLIN, WARREN, and KRATZ, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

ON REMAND TO THE EXAMINER

This is an appeal from the final rejection of claims 1-12 and 16.

Claim 1 is illustrative:

1. A tire having a tread comprised of a vulcanizable rubber composition comprising:

(A) 100 parts by weight of at least one diene-based elastomer wherein selected from the group consisting of natural or synthetic cis 1,4-

polyisoprene rubber, 3,4-polyisoprene rubber, styrene/butadiene copolymer rubbers, isoprene/butadiene copolymer rubbers, styrene/isoprene copolymer rubbers, styrene/isoprene/butadiene terpolymer rubbers, cis 1,4-polybutadiene rubber and medium to high vinyl polybutadiene rubber having a vinyl 1,2- content in a range of about 15 to about 85 percent and emulsion polymerization prepared butadiene/acrylonitrile copolymers;

(B) from about 1 to about 60 phr of a starch/synthetic plasticizer composite; and

(C) from about 0.1 to about 10 phr of an adduct of maleic anhydride and polybutadiene.

The Examiner relies upon the following references as evidence of obviousness:

Corvasce	US 5,672,639	Sept. 30, 1997
Huynh-Tran	US 2003/0152758 A1	Aug. 14, 2003

Appellants' claimed invention is directed to a tire tread comprising a vulcanizable rubber composition that comprises, inter alia, an adduct of maleic anhydride and polybutadiene. According to Appellants, "the present specification includes evidence of unexpected results to obviate any finding of obviousness" with respect to the inclusion of an adduct of maleic anhydride and polybutadiene to the claimed vulcanizable rubber composition (page 6 of Br., last paragraph).

Appealed claims 1-12 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Corvasce in view of Huynh-Tran. The Examiner acknowledges that Corvasce does not teach the use of the claimed adduct of maleic anhydride and polybutadiene in the rubber compositions, but it is the Examiner's position that it would have been obvious for one of ordinary skill in the art to incorporate the adduct, as taught by Huynh-Tran, in the rubber

compositions of Corvasce because Huynh-Tran successfully exemplifies "incorporating a maleinized polybutadiene in a similar rubber composition with increased adhesion to polymeric fibers" (page 6 of Answer, first paragraph).

Appellants contend that Huynh-Tran's teaching of using a maleinized polybutadiene to improve adhesion of the rubber composition to a polyester fiber provides no teaching or suggestion that "such a rubber composition including maleinized polybutadiene may advantageously be used with a starch/synthetic plasticizer composite filler as taught by Corvasce" (page 5 of Br., second full sentence). Appellants maintain that "[t]he Examiner has not established that a rubber composition that shows advantageous adhesion to an epoxy adhesive treated polyester fiber as in Huynh-Tran necessarily will show advantageous interaction with a starch/synthetic plasticizer composite filler as in the present claims" (page 5 of Br., third full sentence). Appellants further argue that "[w]ithout more to establish the similarity of the polyester fiber as taught in Huynh-Tran to the starch/synthetic plasticizer composite filler as in the present claims, or the similarity of the adhesion to polyester fiber compared to the adhesion to a starch/synthetic plasticizer composite filler, the Examiner's proposed motivation for combining the teachings of Huynh-Tran and Corvasce ... fails" (page 5 of Br., penultimate full sentence). Also, as noted above, Appellants devote pages 6-8 of the Brief to arguments directed to Specification data which demonstrates unexpected results.

The Examiner's sole response to Appellants' arguments is the statement that "[s]ince there is no negative teaching in Corvasce et al. to teach one of ordinary skill in the art not to incorporate the maleinized

polybutadiene teachings of Huynh-Tran into Corvasce et al., the motivation set forth for the rejection of claims 1-12 and 16 is proper" (page 7 of Answer, first paragraph). Manifestly, the absence of a negative teaching in the prior art is not the standard for determining obviousness within 35 U.S.C. § 103. Also, it is fundamental that when an applicant submits evidence of unexpected results, the evidence must be analyzed and weighed by the Examiner in determining the obviousness of the claimed invention.

Accordingly, this application is remanded to the Examiner to complete the examination that appellants and the public are entitled to. The Examiner is directed to address Appellants' substantive arguments appearing at pages 4-6 of the brief, and evaluate the weight of the Specification data in light of the arguments set forth at pages 6-8 of the Brief. The Examiner must determine whether the Specification data is commensurate in scope with the degree of protection sought by the appealed claims,¹ whether the Specification data presents a fair comparison with the closest prior art,² and whether the specification data would be considered truly unexpected to one of ordinary skill in the art.³

¹ *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983).

² *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1263-64 (Fed. Cir. 1984).

³ *In re Merck & Co.*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986); *In re Klosak*, 454 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972).

Appeal 2007-0103
Application 10/603,023

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board.

REMANDED

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The Goodyear Tire & Rubber Company
Intellectual Property Dept. 823
1144 East Market Street
Akron, OH 44316-0001